



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/016,743	01/30/98	ROSENBLATT	176/60192 (UK)

HM12/0604
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EXAMINER
EYLER, Y

ART UNIT	PAPER NUMBER
1642	

DATE MAILED: 06/04/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/016,743

Applicant(s)
Rosenblatt et al.

Examiner
Yvonne Eyler

Group Art Unit
1642



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 03 months thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-76 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-76 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-10 and 25, drawn to chimeric molecules comprising a binding domain and a chemokine and compositions thereof, classified in class 514, subclass 12.
 - II. Claims 11-15, drawn to genes encoding a chimeric molecule comprising a binding domain and chemokine, vectors and host cells, classified in class 536, subclass 23.5 and class 435, subclass 69.1 and 320.1.
 - III. Claims 16, 17, and 19-24, drawn to a method of stimulating immune response by administering a chimeric molecule of binding domain and chemokine, classified in class 514, subclass 12.
 - IV. Claim 18, drawn to a method of gene therapy administering genes encoding a chimeric binding domain/chemokine, classified in class 514, subclass 44.
 - V. Claims 26-35 and 50, drawn to chimeric molecules comprising a binding domain and costimulatory ligand as well as compositions thereof, classified in class 514, subclass 12.
 - VI. Claims 36-40, drawn to genes encoding chimeric molecules comprising binding domain/co-stimulatory molecule, classified in class 536, subclass 23.5, and class 435, subclass 69.1 and 320.1.
 - VII. Claims 41, 42, and 44-49, drawn to a method of stimulating immune responses by administering chimeric molecules comprising binding domains and co-stimulatory molecules, classified in class 514, subclass 12.

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- VIII. Claim 43, drawn to a method of gene therapy comprising administering genes encoding chimeric molecules comprising binding domains and co-stimulatory molecules, classified in class 514, subclass 44.
- IX. Claims 51, 52, and 54-62, drawn to a method of stimulating immune response by administering two chimeric molecules comprising a binding domain and a chemokine and a binding domain and a co-stimulatory molecule, classified in class 514, subclass 12.
- X. Claim 53, drawn to method of gene therapy comprising administering two genes encoding chimeric molecules comprising a binding domain and a chemokine and a binding domain and a co-stimulatory molecule, classified in class 514, subclass 44.
- XI. Claims 63-76, drawn to a chimeric molecule comprising a binding domain and two effectors, a chemokine and a co-stimulatory molecule, classified in class 514, subclass 12.

2. The inventions are distinct, each from the other because of the following reasons

3. The inventions of Groups I, II, V, VI, and XI are drawn to entirely different products having different chemical structures. The search of any single product is not cohesive with the search for any of the other products and does not supply information about any of the other products. The chimeric molecules of Groups I, V, and XI are completely different molecules comprising different linked entities and require unique searches. Likewise, the nucleic acids

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encoding the molecules are completely different chemically and structurally, each from the other and from the proteins they encode.

4. Inventions Groups III, VII, IX and I, V, XI are related as product and process of use.

The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product may be used to generate antibodies or stimulate cells *in vitro*. Furthermore, the methods of Groups III, VII, and IX are completely different, requiring different method compositions.

5. Inventions Groups IV, VIII, X and II, VI, and IX are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product may be used to produce protein or in hybridization assays. Furthermore, the methods of Groups IV, VIII, and X are completely different, requiring different method compositions.

6. The methods of Groups IX, X differ from the methods of Groups III, IV, VII, VIII by requiring completely different method compositions not in common with the methods of Groups III, IV, VII, VIII. None of the respective methods requires the combination of products and steps

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required by Groups IX and X. Groups IX and X further differ by requiring completely different method compositions from each other.

7. Because these inventions are distinct for the reasons given above and the search required for any single Group is not required for any other Group, restriction for examination purposes as indicated is proper.

8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

9. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvonne Eyler, Ph.D. whose telephone number is (703) 308-6564. The examiner can normally be reached on Monday through Friday from 830am to 630pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, can be reached on (703) 308-4310. The fax phone number for this Group is (703) 305-3014 or (703) 308-4242.

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Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [paula.hutzell@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.


Yvonne Eyler
Patent Examiner

Yvonne Eyler, Ph.D.
Patent Examiner
May 31, 1999